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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,218	03/29/2004	Ferdinand Kersten	251103-1021	3040

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EXAMINER


SAETHER, FLEMMING

ART UNIT	PAPER NUMBER
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3677

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

 Office Action Summary	Application No. 10/812,218	Applicant(s) KERSTEN, FERDINAND	
	Examiner Flemming Saether	Art Unit 3677	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 21-48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,712,570. Although the conflicting claims are not identical, they are not patentably distinct from each other because the features of the claims of the instant application are covered by the more detailed claims of the parent application.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 41-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Kibblewhite (US 5,131,276). In the embodiment of Fig 8, Kibblewhite discloses

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threaded bolt comprising a head end having a outermost radial measurement plane and an insertion end having a radial measurement plane formed by a flat bottom (at 85, 87) of a recess bounded by a circumferential wall which has an outermost distal end at a point changes into a flank via a sharp buckle. The radial planes are used as ultrasonic measuring planes. The head end being capable of detachably receiving a sensor.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21-25, 27-35, and 37-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over DAF Standard Prod 9257 in view of Kibblewhite (US 5,131,276). In Fig. 4 on page 6, DAF Standard discloses a threaded bolt for use in ultrasonic measurement for determining the tension in a threaded bolt. The insertion end of the bolt (left side of Fig. 4) has a single flat radial measurement plane formed as a flat bottom of a recess bounded by a first circumferential plane at an angle of 45 to 75 degrees which at an outermost portion forms a sharp point (labeled "sharp") and "via a buckle" transitions into a second circumferential plane (not labeled) which is shown at an angle of 45 degrees or less. A head end of the bolt (right side of Fig. 4) is disclosed but, not as having a single flat perpendicular measurement plane. Kibblewhite disclose a bolt for ultrasonic measurement wherein in the embodiment of Figs. 1 and 2, the head

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is shown as having a single flat perpendicular measurement plane (15) and a further discloses a sensor (23) to be placed there against. The sensor is capable of being removable or alternatively, the sensor could be read as the "contact means" (the paragraph beginning line 27) disclosed in Kibblewhite. At the time the invention was made, it would have been obvious for one of ordinary skill in the art to form the head of DAF Standard with a single flat measurement plane as disclose in Kibblewhite since Kibblewhite discloses the single flat surface to a recessed flat surface as currently employed in DAF Standard (see DAF Standard Fig. 4, Detail B). The single flat surface would be superior because it would be easier to manufacture and thus more economical. The means by which the insertion end is formed is a product-by-process limitation where only the final product is considered for patentability. The insertion end is read as "truncated" and lastly, the first and second "normal" are read as opposite one another since there is no structure to preclude such an understanding.

Claims 26 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over DAF Standard in view of Kibblewhite as applied to claims 21, 31 and 35 above, and further in view of Brown (US 2,778,265). Brown discloses a third circumferential surface (20) at an angle of 35 degrees contiguously provided with a thread. At the time the invention was mad, it would have been obvious for one of ordinary skill in the art to provide the bolt of modified DAF Standard with a third circumferential surface as disclosed in Brown to optimally form a transition tin to the threads of the bolt.

Response to Remarks

The rejections under section 112 first and second paragraphs have been obviated in view of applicant's amendments.

The Double Patenting rejection has been maintained because the Terminal Disclaimer has not been received.

Applicant argues that in Kibblewhite's embodiment shown in Fig. 8, the transducers are permanent to the distal end of the bolt and as such cannot meet the limitation wherein the proximal head end is adapted to receive a sensor. In response, the examiner does not disagree with applicant's understanding of Kibblewhite but, maintains that Kibblewhite continues to read on the claims, even as amended. Initially, it should be noted that the limitation relied upon by is that the "head end is *adapted* to detachably receive a sensor" [emphasis added] thus only requiring the prior art be capable of meeting that limitation. In regards to Kibblewhite's Fig. 8 there is nothing to preclude the head from receiving a removable sensor, thus meeting the limitation.

In regards to the combination, applicant argues Kibblewhite along the same lines. Specifically, applicant contends that Kibblewhite cannot meet the limitation of "the proximal head end is adapted to detachably receive a sensor" since in Kibblewhite, the sensor is permanently attached. In response, the examiner again does not dispute applicant's understanding of Kibblewhite but, here again the limitation relied upon by

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applicant is merely defined as "adapted to". Although the sensor most likely would not be removed it *could* be removed thus meeting the limitation that the head end is "*adapted to detachably receive a sensor*".

Furthermore, and alternatively, Kibblewhite discloses a contact means (column 4, paragraph beginning line 27) engageable with the electrode means. In which case, the electrode means would be considered a part of the bolt, which is disclosed as being on the head in Figs. 1 and 2 the engageable contact means would read on the detachable sensor.

Applicant next argues that there would be no motivation for combining since it would change the principle of operation of the prior art invention. Specifically, the DAF standard bolt would not be modified to remove the recesses since it would adversely affect the production technique of the bolt. In response, and without agreeing with applicant's understanding of the DAF standard bolt, the combination would not require the recess of the DAF standard bolt to be removed since the lower surface of the recess includes the end perpendicular to the axis in fact even Kibblewhite contemplates the recess (Figs. 3 and 6) forming the end receiving the sensor. There is no structure claimed which would preclude the inclusion of the recess and furthermore, even if the claims required a completely flat proximal end surface the reference to Kibblewhite teaches to substitute completely flat and recessed end surfaces.

Applicant's subsequent remarks add nothing new but, instead rely on the preceding arguments therefore; no further response is believed necessary.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Flemming Saether whose telephone number is 703-308-0182. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on 703-306-4115. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Flemming Saether
Primary Examiner
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